

Also, Applicant requests of Examiner to be intellectually honest; which, for instance, means that he not represent something as being clearly so except if indeed he really were to clearly see that such be the case.

Thus, if Examiner were to represent that a certain proposed modification be attainable as well as beneficial, it must be clear to Examiner that this proposed modification be both attainable and beneficial; which, of course, means that it must be attainable clearly without resulting in collateral consequences sufficient to negate the anticipated benefit.

In this connection, Examiner must be particularly careful of not assuming the position of an expert.

Also, Examiner must be careful to identify any inherent assumptions and positions underlying his conclusions.

To understand the implications of inherent assumptions and positions, Examiner is asked to carefully read the following discussion.

In holding a claimed invention as representing nothing but obvious modifications of the teachings of a set of applied references, Examiner inherently also holds that effectuating these modifications are not likely to result in any collateral consequences of such nature as to negate the benefits sought by the proposed modifications in the first place.

However, unless it be clear to the skilled artisan that a given modification is not likely to lead to consequences of such nature as to negate any sought-after benefit, the skilled artisan would not find this given modification to be one that he obviously would effectuate. For him to actually effectuate some given modification, it must be clear that such modification will be unlikely to cause collateral consequences of such nature as to negate whatever benefit he might otherwise have expected from the modification.

{Which, of course, is not to say that he might not consider it obvious to try to effectuate this modification. However, as is well established in case law, "obvious to try" is not a proper criterion on basis of which to hold a claimed invention obvious under 35 USC 103.}

Thus, in the absence of evidence to the effect that no collateral consequences (of such nature as to negate the sought-after benefit) are likely to result, it is improper for Examiner to hold Applicant's claimed invention to be unpatentable under 35 USC 103.

In this connection, Examiner is reminded of the fact that he can not presume himself to possess any particular level of expertise in the art to which the claimed invention pertains; which therefore means that Examiner must refrain from taking any position which inherently would require of him to have such expertise. Thus, Examiner is not in a position to render a meaningful opinion with respect to whether or not a proposed modification is likely to give rise to significant negative collateral consequences, except in situations where the proposed modification is so simple and straightforward as not to require the understanding and experience of a skilled artisan in order to assess its likely impact.

In other words, in case of any proposed modifications of prior teachings, it would be improper (i.e., intellectually dishonest) for Examiner to take the position that no significant negative collateral consequences are likely to occur, except if it indeed be clear to him that such be the case.

Applicant has presented the above-identified line of reasoning to the Board of Appeals (see Papers Nos. 58 and 59 in instant File Wrapper), which rejected it on basis of what Applicant clearly sees as highly inaccurate reading of facts and faulty reasoning.

As an example of the Board's inaccuracy and faulty reasoning, Applicant provides an analysis of the following allegation by the Board.

"Appellant argues that the Board has overlooked the "collateral consequences" which might occur in combining the teaching of references to such extent as "to negate the benefit sought by such proposed modification."".

However, the Board is materially inaccurate in its reading of Applicant's position and it utterly fails to perceive the point.

Applicant does not argue "that the Board has overlooked" any collateral consequences.

Instead, Applicant argues that the Board may not have the expertise to see whether or not there might be collateral consequences of such nature as to negate the benefit sought by some given proposed modification.

Clearly, a responsible artisan would not actually effectuate a modification of some prior art teachings except if he can clearly see that such modification would not result in collateral consequences of such nature as to negate any benefit he might otherwise have expected from the modification.

The above situation is quite similar to that associated with a newly developed drug.

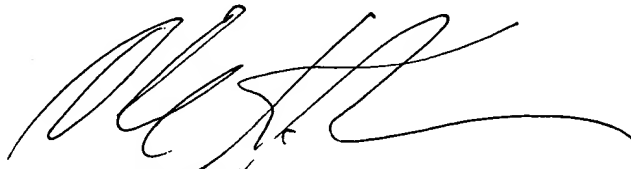
If the newly developed drug were to constitute a modification of an old drug, and even if it be clearly perceived to have significant benefit, a responsible party would not actually effectuate such modification (so as actually to make the new drug) except after it had been thoroughly shown that the use of the new drug would not result in collateral consequences of such nature as to outweigh the perceived benefit. Certainly, a responsible party (even if he be an acknowledged expert) would not assume the position of being enough of an expert to see with sufficient certainty, without actually trying and verifying by extensive testing, that no such collateral consequences would result.

And so it is with respect to a modification of an electronic circuit as well: A responsible artisan would not in reality effectuate a modification of some prior art electronic circuit -- even if he could perceive that such modification would yield some benefit -- except if he could also see that this modification would not result in collateral consequences of such nature as to negate the perceived benefit.

{On the other hand, he might consider it obvious to try to effectuate such modification; but, as stated above, obvious to try is not the appropriate standard on which to judge obviousness under 35 USC 103.}

Thus, given the uncertainties nearly always associated with a proposed modification of prior art teachings aimed at attaining some benefit, in order to prove obviousness under 35 USC 103, it is necessary for Examiner, not merely to assume, but somehow to substantiate that the skilled artisan would not have had reason to suspect (even on a generalized basis) that such proposed modification might result in consequences of such nature as to negate the aimed-for benefit.

Especially in a situation involving the combination and/or modification of two different electronic concepts, circuits and/or disclosures, to call upon Applicant to spell out what those negative consequences will be is equivalent to asking of Applicant far more than even top experts would be hard put to responsibly answer.



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